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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/808,427

03/25/2004

Jon Gingrich

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22852

7590

02/04/2009

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER  
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EXAMINER

NGUYEN, TUAN VAN

ART UNIT

PAPER NUMBER

3731

MAIL DATE

DELIVERY MODE

02/04/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/808,427	<b>Applicant(s)</b> GINGRICH ET AL.	
	<b>Examiner</b> TUAN V. NGUYEN	<b>Art Unit</b> 3731	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 October 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3,7,8,13-19,21-44,46,48,49,51-61 and 72-90 is/are pending in the application.  
     4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,7,8,13,15-17,23,28,29,32-37,40,41,44,48,49,51,53-57,60,61 and 72-90 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/22/08</u> .  | 6) <input type="checkbox"/> Other: _____                          |

Continuation of Disposition of Claims: Claims withdrawn from consideration are 14,18-22,24-27,30,31,38,39,42,43,46,52,57-59 and 62-71.

## DETAILED ACTION

### *Response to Amendment*

1. According to the amendment filed on October 22, 2008, claims 4-6, 9-12, 20, 45, 47, 50, and 62-71 have been canceled and claims 72-90 are new. Accordingly, claims 1-3, 7, 8, 13-19, 21-44, 46, 48, 49, 51-61 and 72-90 are pending in this present application and claims 14, 18-22, 24-27, 30, 31, 38, 39, 42, 43, 46, 52, 57-59 and 62-71 have been withdrawn and claims 1-3, 7, 8, 13, 15-17, 23, 28, 29, 32-37, 40, 41, 44, 48, 49, 51, 53-57, 60, 61 and 72-90 are presented for examination.

### *Response to Arguments*

2. Applicant's arguments filled on October 22, 2008 have been fully considered but they are moot in view of new ground of rejection.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. **Claims 72-74, 83, 84 and 89-90 are rejected under 35 U.S.C. 102(b) as being anticipated by Alden et al. (U.S. 5,364,355).**

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5. Alden et al. teach (Figs. 1-3) holding system for coiled intravascular products comprising: a handle 17; an end effector assembly 13; and an elongate, flexible member 14 forming loops 19 and connecting the handle to the end effector assembly, wherein a first grooves defined by the handle houses each of the loops 19. Figures 2 and 3 of Alden's drawing show the groove has a length greater than the aggregate diameter of the loops and the width of the grooves substantially the same as a diameter of the elongate member.
6. As to claim 84, Examiner contends that the handle of Alden et al. device includes 17 and 18, wherein the handle of Alden defines at least one notch that receive flexible member 14 (Fig. 2 or Fig. 3) circumferentially adjacent to the another notch or groove that receive flexible member 14 configured to accommodate a second portion of the elongate member 14 (see Fig. 1).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:
  1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
9. **Claims 1-3, 7, 8, 13, 15-17, 23, 28, 29, 32-37, 40, 41, 44, 48, 49, 51, 53-57, 60, 61 and 72-90 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yanamoto (U.S. 6,299,630) in view of Dever (U.S. 2,587,707).**
10. Yanamoto discloses (Fig. 1) a biopsy forceps device 3 comprising: a handle 19; an end effector assembly 4; an elongated, flexible member 10 connecting the handle to the end effector assembly; and a slider 43 or spool, wherein the slider includes a proximal and a distal portions and a central portion, for controlling of end effector. Yanamoto discloses the invention substantially as claimed except for the slider or spool further comprises grooves on the distal portion, proximal portion and the central portion, wherein the grooves configured to accommodate at least one of a portion of the elongate member and a portion of the end effector assembly.
11. However, among the problems common to known biopsy forceps, catheter generally is that these sterilized instruments are very long and flexible, making packaging, storage and handling difficult. The instruments are frequently coiled when packaged. When the packaging is opened, the instruments can

spontaneously uncoil, become unmanageable, potentially falling on the floor, and becoming contaminated or being damaged. Thus, there is a need for a feature that retains these types of instruments in a coiled configuration when unpackaged.

Alden et al. teach (Figs. 1-3) a system 18 includes plurality of grooves 23 for holding flexible elongated product in a coiled arrangement to minimize the risk of aforementioned problems. Further, Dever discloses (Fig. 5) a device or a spool that includes groove on the distal, proximal portion and on the central portion for holding flexible elongated electrical cord or the like thereby, providing a neat and ornamental appearance (col. 1). Based on the teaching of Alden et al. and Dever, it would have been obvious to one of ordinary skill in the art to incorporate the plurality of grooves as disclosed by Alden et al. and Dever into the slider or spool of Yanamoto so that it too would have this advantage because it has been held that use of combine and use of known technique to improve similar devices in the same way is old and well known in the art.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TUAN V. NGUYEN whose telephone number is (571)272-5962. The examiner can normally be reached on M-F: 9:00 AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, AnhTuan Nguyen can be reached on 571-272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/T. V. N./  
Examiner, Art Unit 3731



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/Anhtuan T. Nguyen/

Supervisory Patent Examiner, Art Unit 3731